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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/777,057 | 02/05/2001 | David Leslie | 11-SW-4913 | 2498 |

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EXAMINER

BARTUSKA, FRANCIS JOHN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3627

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,057

Applicant(s)

LESLIE ET AL.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 32-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 32-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 32-38 are rejected under 35 U.S.C. 101 because they are directed to nonfunctional descriptive material. Nonfunctional descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data. Where certain types of descriptive material are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material

stored in a computer-readable medium does not make it statutory.

Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

A listing of rules and a listing of results as claimed in claims 32-38 is still a mere arrangement of data, it is not instructions to a computer to perform a function according to the rules to achieve the results.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each

claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 15-18 and 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Smith et al. Henson discloses a system and method for automatically customizing and specifying a purchase using a computer network-based system including a server coupled to a database 24 and a client system. The system includes a configurator 18, a plurality of interfaces that include drop down menus, see Figs 3A, 3B, 4 and 5, a pricing module 28 and means to submit an order and arrangement payment and delivery of the order. Henson does not disclose making a drawing of the selected configuration. Smith et al disclose a graphical user interface for specifying a configuration of a product to be ordered that includes making a drawing of the selected product, see col. 10, lines 36-40. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Smith et al to provide the system of Henson

with means to make a drawing of the selected configuration for use in other applications.

5. Claims 1-10, 14, 19 and 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Smith et al as applied to claim 15 above in further view of Farrell et al. Henson, as modified by Smith et al, discloses a system and method for automatically customizing and specifying a purchase with all the features of the applicants' claimed invention except the items being purchased are not disclosed as being switchgear products. Farrell et al disclose a system for ordering any sort of industrial product over the Internet. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Farrell et al to offer for sale any kind of industrial product, including switchgears, with the system of Henson.

6. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Smith et al and Farrell et al as applied to claim 1 above. Further, Henson discloses displaying delivery information and customer information in Figs. 7 and 9. Displaying

other information of the transaction, such as transaction numbers or methods of confirmation, would involve only an obvious design choice to one of ordinary skill in the art in view of the many sorts of information displayed by Henson. Moreover, merely calling for printing of price quotes would involve only a notorious expedient of the art.

7. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Farrell et al. The necessary working memory of the online store of Henson is a computer readable medium that receives a record of a customer submitted configuration, matches the customer submitted configuration for a particular configuration of a system and records the results for purchase by the customer. Henson does not disclose that the items being purchased are switchgear products. Farrell et al disclose a system for ordering any sort of industrial product over the Internet. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Farrell et al to offer for sale any kind of industrial product, including switchgears, with the system of Henson.

Response to Arguments

8. In response to applicant's argument that Henson is not for automatically customizing and specifying a parallel switchgear system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The applicants' remarks that there is no motivation to combine Henson and Farrell et al have been considered but have not been found persuasive because Farrell et al teach ordering any type of industrial product using inter-computer networks such as the Internet. Therefore, in view of this teaching of Farrell et al, an inter-computer network that

is for ordering industrial products such as computers can be used to order any industrial product. Hence, the network of Henson can be used to order any industrial product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

fjb

F. J. BARTUSKA
PRIMARY EXAMINER